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APPLICATION NO.	FI	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,083 01/05/2001		01/05/2001	Edward Green	00487.00007	4709
22907	7590	03/12/2002			
BANNER			EXAMINER		
1001 G STREET N W SUITE 1100				RAO, MANJUNATH N	
WASHING	TON, DC	20001	ART UNIT	PAPER NUMBER	
				1652	
				DATE MAILED: 03/12/2002	7

Please find below and/or attached an Office communication concerning this application or proceeding.

<u> </u>	Application No.	Applicant(s)				
,	09/754,083	GREEN ET AL.				
Office Action Summary	Examiner	Art Unit				
	Manjunath N Rao	1652				
The MAILING DATE of this communication app						
Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status						
1) Responsive to communication(s) filed on <u>08 F</u>	ebruary 2002 .					
	is action is non-final.					
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims						
4) Claim(s) 1-25 is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)☐ Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) <u>1-25</u> are subject to restriction and/or e	election requirement.					
Application Papers						
9)☐ The specification is objected to by the Examiner	' .					
10)☐ The drawing(s) filed on is/are: a)☐ accep	ted or b)⊡ objected to by the Exa	miner.				
Applicant may not request that any objection to the						
11)☐ The proposed drawing correction filed on	is: a) approved b) disappro	ved by the Examiner.				
If approved, corrected drawings are required in reply to this Office action.						
12)☐ The oath or declaration is objected to by the Examiner.						
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).						
a) ☐ The translation of the foreign language provisional application has been received. 15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.						
Attachment(s)						
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Informal F	(PTO-413) Paper No(s) Patent Application (PTO-152)				

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DETAILED ACTION

Claims 1-25 are currently pending in this application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-16, drawn to a Gram positive bacterium, classified in class 435, subclass
 243.
- II. Claims 17-20, drawn to a method for producing ethanol, classified in class 435, subclass 161.
- III. Claims 21, drawn to a method for producing L-lactic acid, classified in class 435, subclass 139.
- IV. Claims 22-25, drawn to nucleic acid molecule and a plasmid, classified in class536, subclass 23.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II, III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the bacterium can be used for production for recombinant proteins as opposed to its use in the method of making ethanol or lactic acid.

Invention I and IV are patentably distinct from each other. The bacterium of group I and the nucleic acid molecule of group IV are physically and chemically different from each other

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and have different utilities such as the bacterium which can be used to make ethanol and the nucleic acid molecule which can be used as a vector to transform bacteria. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

Inventions II and III are patentably distinct from each other. The method of making ethanol of group II and the method of making lactic acid are unrelated as they comprise different steps and result in products which are chemically distinct with different utilities. While the ethanol is used as an industrial solvent and as fuel, lactic acid is used as a starting material to synthesize a variety of organic compounds. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

Invention II, III and IV are patentably distinct from each other. The method of producing ethanol of group II and the method of producing lactic acid of group III neither makes the nucleic acid of group IV nor does it use the product of group IV. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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A telephone call was made to Steven Schad on 2-25-02 to request an oral election to the

above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an

election of the invention to be examined even though the requirement be traversed (37 CFR

1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR

1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Manjunath Rao whose telephone number is (703) 306-5681. The

Examiner can normally be reached on M-F from 6:30 a.m. to 3:00 p.m. If attempts to reach the

Examiner by telephone are unsuccessful, the Examiner's supervisor, P.Achutamurthy, can be

reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is

(703) 305-3014. Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Manjunath N. Rao. Ph.D.

March 4, 2002

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